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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 09/890,832   | 11/09/2001  | Patrice Vincent      | Q65738                  | 8154             |
| 7590   | 04/13/2004  |                      | EXAMINER                |                  |
| Sughrue Mion Zinn Macpeak & Seas<br>2100 Pennsylvania Avenue NW Suite 800<br>Washington, DC 20037-3213 |             |                      | RAMANA, ANURADHA        |                  |
|  |             |                      | ART UNIT                | PAPER NUMBER     |
|  |             |                      | 3732                    | 12               |
|  |             |                      | DATE MAILED: 04/13/2004 |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/890,832             | VINCENT, PATRICE    |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Anu Ramana             | 3732                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 February 2004.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4,7-9 and 11-15 is/are rejected.
- 7) Claim(s) 5,6 and 10 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1 and 11-13 are objected to because of the following informalities.

In claim 1, “a lens when not deformed” is confusing. It is suggested that this phrase be replaced with “an undeformed lens” for clarity.

Claims 11-13 recite the phrase “further comprising a lens” which is confusing since “a lens” is already a part of claim 1 on which claims 11-13 depend.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 3-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 3, it is unclear what is meant by “forming a cylinder.....body.” Due to their resiliency, the fingers must bear against the inside wall of the syringe body which is cylindrical in shape.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 9 and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Feingold et al. (US 5,772,666).

Feingold et al. disclose a one-piece lens injecting apparatus or device 10 having a syringe body 12 with a piston 18, a cylindrical portion 12a containing a preloaded lens in an undeformed state, a conical intermediate portion 12b and an injection endpiece 24 wherein an injection end of the piston 18 has a plurality of paddles or fingers 22n that bear against the curved inside walls of syringe body 12 (Figures 1 and 16; col. 2, lines 23-36 and lines 45-56; col. 6, lines 1-30; col. 7, lines 37-41 and col. 9, lines 25-34).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-8 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feingold et al. (US 5,772,666).

Regarding claim 7, the use of sealing gaskets or stoppers is well known in the art for the purpose of sealing fluid-filled syringes (refer cited art in the conclusion). Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a sealing gasket and a stopper in the Feingold et al. device since it was known in the art to provide these structures in a fluid-filled syringe for the purpose of sealing or containment.

Regarding claim 8, Feingold et al. disclose that device 10 can be manufactured from structural grade plastic or metal to allow autoclaving thereof (col. 10, lines 34-37). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the Feingold et al. device of materials capable of withstanding heat, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use, sterile use by autoclaving, as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 14 and 15, Feingold et al. discloses two paddles or fingers 22n (col. 12, lines 1-2). It would have been obvious to one having ordinary skill in the art at the time the

invention was made to have provided three fingers, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feingold et al. in view of Blake (US 6,280,449).

Regarding claims 14 and 15, Feingold et al. disclose two paddles or fingers 22n (col. 12, lines 1-2).

Blake teaches a lens-injecting device with a pusher element or “plunger” or “piston” 14 with at least two push-blades of “fingers” to facilitate passage of an intraocular lens through a conical sleeve 20 (Figure 1 col. 2, lines 37-46, col. 8, lines 9-15 and lines 44-59 and col. 12, lines 1-2).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided three fingers, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

#### *Allowable Subject Matter*

Claims 5, 6 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims in independent form including all of the limitations of the base claim and any intervening claims.

#### *Response to Arguments*

Applicant's arguments under “REMARKS” in Paper No. 11 filed on February 3, 2004, with respect to claims 1-4 and 7-9 have been fully considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anuadha Ramana*  
April 9, 2004

*Kevin Shaver*  
KEVIN SHAVER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700